

REMARKS

Claims 1-35 and 45-52 will be pending upon entry of the present amendment. Claim 17 is amended, claims 36-44 are cancelled, and claims 45-52 are newly submitted herewith.

Objections to the drawings

The Examiner has objected to the drawings as not showing every feature of the claimed invention. Though the Examiner did not specify by number the claim(s) believed to recite material not shown in the figures, applicant believes that claim 17 is the only claim that includes language similar to that recited in the Office Action. Claim 17 has been amended to clarify the scope thereof, and to resolve the Examiner's objection. Applicant notes that the amendment to claim 17 was not made for the purpose of distinguishing the claim over prior art.

Rejections under 35 U.S.C. § 112

Claims 17-35 were rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement. Applicant believes that the amendment made to claim 17 to resolve the previously discussed objection renders this rejection moot. Accordingly, applicant will not further address the matter.

Rejections under 35 U.S.C. § 102

Claims 1, 3-7, 17, and 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Onion (U.S. 6,378,214).

The standard that must be met to reject a claim under § 102 is outlined in the MPEP at § 2131:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.... The identical invention must be shown in as complete detail as is contained in the ... claim.

(Citations omitted.)

Claim 1 recites, in part, "the end face of the handle being configured such that, as the blade is pivoted from the closed position towards the open position, the second locking

element, when in the first position, is spaced from the end face of the handle for a substantial portion of the movement of the blade from the closed position to the open position.” Onion ‘214 does not anticipate this limitation. In rejecting claim 1, the Examiner points to Figure 3 of Onion ‘214 as showing this feature. Claim 3 is reproduced herebelow:

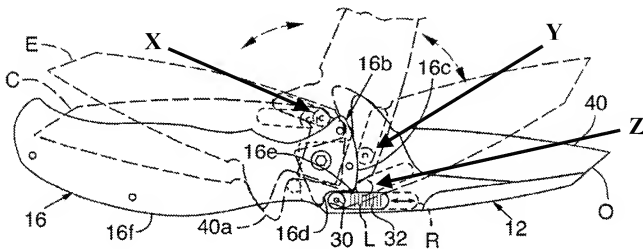


Figure 3 of Onion ‘214

Arrows designated X, Y, and Z have been added by the undersigned representative to illustrate the difference from the present invention. This figure 3 shows the blade of the pictured knife in five different positions between the closed position C and the open position O. In each position, the post 30 is shown, relative to the end 16b of the handle. It can be seen that as the blade is moved from the closed position toward the open position, the post 30 has made contact with the handle at X by the time the blade is at the position marked E. Two additional blade positions are shown between position E and position O, and it can be seen that at both of these other positions the post 30 is in contact with the end of the handle, as indicated for illustrations by the arrows at Y and Z. Furthermore, one of ordinary skill in the art will recognize that the flat arc formed by the end surface 16b of the handle is closest to the pivot point of the blade at about Y. Thus, because it can be seen that the post 30 contacts the handle end 16b at Y, it is clear that there is no point between X and the locked position, at O, where the post is “spaced from the end face of the handle,” as recited in claim 1. Accordingly, Onion ‘214 does not anticipate this feature of claim 1, which is therefore allowable. Dependent claims 2-16 are allowable for additional reasons besides depending from an allowable base claim.

Claim 17 recites, in part, “a post, slidably mounted in the slot, the post, while in the end of the slot, being spaced from the edge surface such that, during blade motion from the closed position towards the open position, the post does not contact the edge surface until just prior to engaging the latching corner of the exposed exterior edge surface as the blade reaches the open position.”

The language “just prior to engaging the latching corner” is supported in the specification, and particularly in Figure 3, which shows the point 24j where the post first contacts the edge surface at a point in the rotation of the blade just before the blade reaches the open position and the post engages the latching surface.

In rejecting claim 17, the Examiner observes that the post “can be held in the 2nd position by the user for the duration of pivoting the blade ... and therefore the ... post would not touch the edge surface ....” This is of no particular relevance, since claim 17 is directed to the condition in which the post is in the end of the slot, and thus does not speak to the situation described by the Examiner. Clearly, Onion ‘214 does not anticipate all the elements of claim 17, which is thus allowable, together with dependent claims 18-26.

#### Rejections under 35 U.S.C. § 103

Claims 2, 8-16, and 19-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Onion.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *MPEP* § 2142.

In rejecting claim 2, the Examiner states that the limitations of claim 2 would have been obvious,

because Applicant has not disclosed that preventing the second locking element from touching the end face of the handle ... provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Onion's design, and applicant's

invention, to perform equally well with either the minimum contact distance as taught by Onion or the claimed minimum contact distance because both ... would perform the same function of guiding the second locking element to the latch equally well.

The Examiner has merely made a conclusory statement, without support in the art. As the Examiner is aware, it is not required that an applicant disclose all the advantages of an invention. In the present case, there are a number of advantages that are provided according to various embodiments of the invention. For example, with respect to the configuration of the end face of the handle, as recited in claim 1, one advantage is that the post does not generate friction by contacting the end face as it moves toward the open position. Not only does this reduce wear on the post and the handle, but it also allows the blade to move more smoothly to the open position. With regard to the locking mechanism, as recited in claim 27, one advantage is that by providing a wide portion of the slot, through which an end of the post can pass, the manufacture of the device is simplified, because the post can be fully assembled before being coupled to the knife blade. The retaining element of claim 28, and the expander of claim 32 provide a simple and inexpensive mechanism for securing the post to the blade. Many of the advantages of the disclosed invention reduce manufacturing costs by reducing the amount of labor required for assembly, or by facilitating automated assembly. While some of the advantages of embodiments of the invention have been provided for the benefit of the Examiner, they are merely exemplary; it is not necessary for the advantages listed here to be present in a given device in order for claims of the invention to read on that device.

It has been shown that Onion '214 does not anticipate claims 1 and 17. The Examiner has not argued that claims 1 or 17 are unpatentable under 35 U.S.C. § 103, and the Examiner has not cited any additional art in rejecting the dependant claims that would render the base claims 1 and 17 obvious, independent of Onion '214. Claims 2 -16 and 18-26 are allowable over the art of record for additional reasons also.

The Examiner has not pointed to any aspect of the prior art that teaches or suggests any of the elements of claims 8-16 and 19-35. Instead, the Examiner states,

It would have been obvious to provide an enlarged end in the slot and an expandable retaining element for preventing the neck from leaving the slot in Onion since the Examiner takes Official Notice of the equivalence of the two different types of slots and prevention means in the connection art and the selection of either of these known slot and prevention structures to form the slot

and retention means of Onion would be within the level of ordinary skill in the art.

Examiner takes Official Notice [of] the fact that providing a slot with an enlarged end and a retaining element to fit into the enlarged end is known in the connection art to be equivalent to a slot without an enlarged end where the retaining element is attached to the neck after the neck has been inserted in the slot for use in the prevention of the neck falling out of the slot. To substitute a slot with an enlarged end and a retaining element ... would have been an obvious functional equivalent.

Furthermore, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide a slot with an enlarged distal end and a retaining element ... because Applicant has not disclosed that enlarging the end of the slot and using an expandable retaining element provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Onion's ... design, and applicant's invention, to perform equally well with either the slot and retention means taught by Onion or the claimed slot and retention device because both would perform the same function of preventing the neck from falling out of the slot equally well.

Applicant strongly disagrees. It would not have been obvious to provide an enlarged end of the slot. This particular feature required additional designs and concept work. As is clear, the prior art '214 patent does not have an enlarged slot; as the Examiner is aware, the same inventor of the current application was the inventor of the prior art '214 patent, yet it was some years and considerable development later that a slot with "an enlarged width at one end" was invented the advantages obtained from such improvement. Some of the advantages of this development have been outlined above.

Whether two devices which are quite different from each other perform equally well is not the standard of patentability. It is whether the modifications would be obvious to one of skill in the art. Whether Mr. Onion the inventor, could conceive of the changes and make them is not the issue, he is the inventor, not a person of ordinary skill in the art. The Examiner has not pointed to any prior art as providing motivation to modify Onion '214.

Applicant believes the Official Notice was taken improperly. The feature for which the Examiner took official notice includes some inventive features that were conceived of by the inventor as unique and novel.

Among these are the features of a retaining element positioned in a first portion of the slot and extending into the second portion of the slot, the use of a ball bearing in a hole as an

expanding element and having the hole expand to enlarge the retaining element are all specific new and unobvious feature for which official notice would not be taken. With regard to Official Notice, the MPEP states,

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. ... [T]he notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute."

\*\*\*

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.

\*\*\*

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. *MPEP* § 2144.03.

Applicant does not believe the facts noticed by the Examiner are common knowledge. The facts noticed by the Examiner are not found in any of that art. Accordingly, applicant respectfully traverses the Official Notices of the recent Office Action, and requests supporting documentary evidence in a subsequent action, or, alternatively, allowance of the claims in question.

In addition to the inappropriate Official Notice, the Examiner has asserted that such facts would be well known to one of skill in the *connection art*. Applicant does not agree that the connection art is relevant and is not sure what is meant by this phrase.

Again, Applicant requests that actual art be cited and provided to show the features asserted by this Examiner to be obvious.

Allowance of claims 8-16 and 19-35 is respectfully requested.

New claims 44-52 are directed to subject matter that is well supported by the specification, and in particular by the embodiments described with reference to Figures 6-9.

Applicant believes that all of the claims remaining in the application are now allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,  
SEED Intellectual Property Law Group PLLC

/Harold H. Bennett II/

---

Harold H. Bennett II  
Registration No. 52,404

HHB:wt

701 Fifth Avenue, Suite 6300  
Seattle, Washington 98104-7092  
Phone: (206) 622-4900  
Fax: (206) 682-6031

807128\_1.DOC